

## Remarks

### I. Provisional Election of Claims Pursuant to 37 CFR §1.142

The Applicants provisionally elect **claims 1 through 9 and claims 21 through 24** in response to the preliminary restriction requirement set forth in the Office Action. Further, the Applicants provisionally elect **species 2) a nitride** and indicate claims reading on the species as follows:

Claims 5 and 6 read on the provisionally elected species; and

Claims 16 and 17 read on the provisionally elected species.

### II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 10 through 19, reciting a method of preparing a negative electrode of a lithium battery, are so closely related to elected claims 1 through 9 and 21 through 24, reciting a negative electrode of a lithium battery and a lithium battery, respectively, that claims 10 through 19 should remain for consideration in the same application. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the product and method claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required. Even if the Examiner considers claims 10 through 19 to be a separate invention from claims 1 through 9 and 20 through 24, the Applicants respectfully request the Examiner to consider claims 1 through 9 and 20 through 24 (Group I) and claims 10 through 19 (Group II) together.

With regard to the provisional election of species, the Applicants provisionally elect the

nitride species - species 2) a nitride - of claim 5 onto which claim 6 reads with specific traversal. For at least the same reasons as above, the Applicants provisionally elect the nitride species of claim 16 onto which claim 17 reads.

However, the Applicants respectfully disagree with the Examiner's determinations of genericness; namely, claims 4 and 24 are not described as generic while similar claims 11 and 22, respectively, are described as generic. As such, the Applicants submit that the lack of description of claims 4 and 24 as generic is in error, and that claims 4 and 24 are, in fact, generic. "In general, a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim." MPEP §806.04(d). For example, claim 4 recites that the material comprising the protective layer comprises a crystalline material. Claim 11 recites the same feature and was determined generic. Therefore, claim 4 is generic, and, for at least similar reasons, claim 24 is also generic. Moreover, the species from which the Examiner required election depended from claim 4.

### III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the Group II claims is directed to a method of preparing a negative electrode of a lithium battery, and elected claims 1 through 10 and 20 through 24 are directed to a negative electrode of a lithium battery and a lithium battery, respectively, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 7/20/07

By: 

Michael D. Stein  
Registration No. 37,240

1400 Eye Street, NW  
Suite 300  
Washington, DC 20005  
Telephone: (202) 216-9505  
Facsimile: (202) 216-9510